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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/782,988	02/13/2001	Hitoshi Sekine	49986-0505	1948

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EXAMINER

EHICHIOYA, FRED I

ART UNIT	PAPER NUMBER
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2172

DATE MAILED: 07/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/782,988

Applicant(s)

SEKINE ET AL.

Examiner

Fred I. Ehichioya

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 4, 6 - 14, 16 - 24, 26 - 31 is/are pending in the application.
- 4a) Of the above claim(s) 5, 15 and 25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 - 4, 6 - 14, 16 - 24, 26 - 31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

1. The application has been reexamined.
2. Applicants cancel claims 5, 15 and 25.
3. Applicants amend claims 1, 6, 7, 12, 16, 17, 22, 26 and 27.
4. Claims 1 – 4, 6 – 14, 16 – 24, 26 - 31 are pending in this office action.

Response to Arguments

5. Applicants' arguments filed in Paper No. 4 have been fully considered but they are not persuasive for the reasons set forth herein below.

Applicants argue:

Argument (1): "As set forth in the office action, Ramsay does not teach or suggest the limitations of claim 5, which are now incorporated into claim 1" (page 7; par. 4 and page 8; par. 1).

Argument (2): "It is respectfully submitted that the limitations of claim 5 added to claim 1 are not taught or suggested by Kern (page 8; par.1).

Test for combining references is not what individual references themselves suggest but rather what the combination of disclosures taken, as a whole would suggest to one of ordinary skill in the art. In re McLaughlin, 170 USPQ 209 (CCPA 1971).

Reference disclosure must be evaluated for all that it fairly suggests and not only for what is indicated as preferred. In re Bozek (CCPA) 163 USPQ 545 1969.

Regarding applicants' arguments 1 and 2: The examiner agrees with the applicants that Ganapathy or Kern does not individually explicitly teach the limitations of claim 5 added to claim 1; However, It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Ramsay with the teaching of Kern wherein the limitations of claim 5 added to claim 1 are taught by Ramsay and Kern.

Regarding claim 1, Ramsay teaches a data storage apparatus comprising: an interface configured to receive digital data (see column 19, lines 64 – 67; column 20, lines 10 – 17 and lines 59 – 67); and

a data processor communicatively coupled to the interface and being configured (see column 27, lines 40 – 43 and lines 64 – 67) to:

automatically receive digital data from the interface and cause the digital data to be stored to a write-once-read-many (WORM) storage device (see column 7, lines 13 – 16 and column 30 lines 22 – 24),

Ramsay does not explicitly teach process a search query against the digital data stored on the WORM storage device, and in response to processing the search query against the digital data stored on the WORM storage device, generate data that identifies data stored on the WORM storage device that satisfies the search query.

Kern teaches process a search query against the digital data stored on the WORM storage device (see column 5, line 50 and column 6, lines 48 – 52), and

in response to processing the search query against the digital data stored on the WORM storage device, generate data that identifies data stored on the WORM storage device that satisfies the search query (see column 5, lines 45 – 50 and lines 63 – 65).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Ramsay with the teaching of Kern wherein the data storage subsystem stores and manages digital data on behalf of various computer users, under direction of a host computer. The motivation is that data transfer operations performed by the invention are consistent and valid among the participating data storage devices. This allows the user to access current data when there is an update.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

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not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1 – 4, 6 – 14, 16 – 24, 26 - 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,502,576 issued to Ramsay, Thomas E. et al. (hereinafter “Ramsay”) in view of U.S. Patent 6,202,124 issued to Kern Robert Frederick (hereinafter “Kern”).

Regarding claim 1, Ramsay teaches a data storage apparatus comprising:
an interface configured to receive digital data (see column 19, lines 64 – 67; column 20, lines 10 – 17 and lines 59 – 67); and

a data processor communicatively coupled to the interface and being configured (see column 27, lines 40 – 43 and lines 64 – 67) to:

automatically receive digital data from the interface and cause the digital data to be stored to a write-once-read-many (WORM) storage device (see column 7, lines 13 – 16 and column 30 lines 22 – 24),

Ramsay does not explicitly teach process a search query against the digital data stored on the WORM storage device, and in response to processing the search query against the digital data stored on the WORM storage device, generate data that identifies data stored on the WORM storage device that satisfies the search query.

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Kern teaches process a search query against the digital data stored on the WORM storage device (see column 5, line 50 and column 6, lines 48 – 52), and

in response to processing the search query against the digital data stored on the WORM storage device, generate data that identifies data stored on the WORM storage device that satisfies the search query (see column 5, lines 45 – 50 and lines 63 – 65).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Ramsay with the teaching of Kern wherein the data storage subsystem stores and manages digital data on behalf of various computer users, under direction of a host computer. The motivation is that data transfer operations performed by the invention are consistent and valid among the participating data storage devices. This allows the user to access current data when there is an update.

Regarding claim 2, Ramsay teaches a WORM storage device (see column 30, lines 22 – 24).

Regarding claims 3, 13 and 23, Kern teaches the data processor is further configured to generate one or more indexes for data stored to the WORM storage device (see column 22, lines 18 – 23; column 27, lines 13 – 21 and column 30, lines 58 – 59).

Regarding claims 4, 14 and 24, Kern teaches the data processor is further configured to generate meta data that describes one or more attributes of the data stored to the WORM storage device (see column 3, lines 20 – 23; column 5, lines 45 – 50 and column 7, lines 1 – 2).

Regarding claims 6, 16 and 26, Kern teaches the data processor is further configured to process the search query against one or more indexes generated by the data processor (see column 6, lines 48 – 52).

Regarding claims 7, 17 and 27, Kern teaches the data processor is further configured to automatically process the search query according to a set of one or more time criteria (see column 6, lines 48 – 56 and column 8, lines 16 - 18).

Regarding claims 8, 18 and 28, Ramsay teaches the digital data includes facsimile data (see column 21, lines 44 – 45).

Regarding claims 9, 19 and 29, Ramsay teaches the digital data includes electronic document data (see column 29, line 53).

Regarding claims 10, 20 and 30, Ramsay teaches the digital data includes printer data (see column 25, lines 39 – 44).

Regarding claims 11, 21 and 31, Ramsay teaches the data is stored on an WORM optical medium (see column 30, lines 22 – 24), and

the data processor is further configured to cause a label to be applied to the WORM optical medium, wherein the label specifies one or more attributes of the data (see column 14, line 64; column 30, lines 23 –24 and lines 58 – 62).

Claims 12 is essentially the same as claim 1 except that it sets forth the claimed invention as a method for storing data rather than a data storage apparatus and therefore rejected for the same reasons as applied hereinabove.

Claims 22 is essentially the same as claim 1 except that it sets forth the claimed invention as a computer-readable medium rather than a data storage apparatus and therefore rejected for the same reasons as applied hereinabove.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fred I. Ehichioya whose telephone number is 703-305-8039. The examiner can normally be reached on M - F 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on 703-305-4393. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-303-3900.

Fred Ehichioya
July 10, 2003


SHAHID AL ALAM
PATENT EXAMINER